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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,070	04/02/2004	Michael K. Brown	555255-012714	2683

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EXAMINER	
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ART UNIT	PAPER NUMBER
2109	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/817,070	BROWN ET AL.	
	Examiner	Art Unit	
	Martin Jeriko P. San Juan	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/24/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is a response to the following case application:

Non-provisional Application: 10/817070 filed on April 2, 2004.

This application claims priority from provisional applications:

60/494369 filed on August 12, 2003

Specification

1. The information disclosure statement filed on January 24, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

   a. "Gnu Privacy Guard (GnuPG) Mini Howto" by Michael Fischer v. Mollard.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims fail to place the invention squarely within one statutory class of invention. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a composition of matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 24 is vague and indefinite because it is unclear whether the medium is programmed or capable of being programmed.

2. Claim 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

b. Independent claim 1 recites receiving data about a security key, using the data for validity check and providing a mobile device's user with a reason for a validity check issue. However, this claim recites features that do not represent

the actual applicant's invention as claimed in the preamble. Thus, the claimed invention in claim 1 is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 1-20 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Bandini et al. [US Pub 2002/0169954 A1].

a. Based on independent claim 1, Bandini et al. teach a method for handling on a communication device a secure message to be sent to a recipient, comprising the steps of: receiving data about a security key associated with the recipient [Security services that involve verification of digital certificates inherently teaches receiving data about a security key associated with recipients. Pg 4, Par 0037]; using the received data to perform a validity check with respect to using the message recipient's security key to send a secure message to the recipient [Pg 4, Par 0037]; wherein an issue exists due to the validity check; determining a reason for the validity check issue [Notification actions are caused when a given

policy is triggered, including security policy. Pg 5, Par 0044]; wherein the reason for the validity check issue is provided to the mobile device's user [The issue is what is being notified.].

b. With regard to dependent claim 2, Bandini et al. teach the method of claim 1, wherein a message is provided to the user indicating the reason that a problem exists with respect to sending a secure message to the recipient in addition to indicating the reason related to the problem [Notifications can be sent to sender, recipient or any email address that is defined by the administrator. Pg 5, Par 0044].

c. With regard to dependent claim 3, Bandini et al. teach the method of claim 1, further comprising the step of allowing the user to resolve the validity check issue through use of the information provided in the validity check reason, wherein the secure message is sent after resolution of the validity check issue by the user [Disposition or alternative actions, after a notification action, are available for the sender. (Pg 5, Par 0044), (Pg 9, Par 0064)].

d. With regard to dependent claim 4, Bandini et al. teach the method of claim 1, wherein the security key is a public key, wherein a user composes a secure message, wherein the composed message is to be encrypted using the recipient's public key [This is inherent in S/MIME protocol. Pg 4, Par 0037].

e. With regard to dependent claim 5, Bandini et al. teach the method of claim 4, further comprising the steps of: creating a list of all of the recipients for the outgoing message; receiving data about the recipients' public keys that includes

certificate information associated with the recipients; performing the validity check with respect to the certificate information associated with the recipients [Secure electronic message is capable of sending to multiple recipients.]

f. With regard to dependent claim 6, Bandini et al. teach the method of claim 1, further comprising the steps of: determining whether a certificate for a recipient can be located; providing as a validity check reason that an intended message recipient's certificate was not located [Digital certificate verification involves querying local directories or trusted remote servers. Pg 6, Par 0047].

g. With regard to dependent claim 7, Bandini et al. teach the method of claim 6, wherein the user is allowed to remove a recipient whose certificate was not located before sending a secure message to another recipient. [A certificate that is deemed invalid, inherently being the recipient, is discarded from the acceptable certificate list. Pg 8, Par 0058].

h. With regard to dependent claim 8, Bandini et al. teach the method of claim 6, wherein the user is allowed to cancel sending the message to a recipient whose certificate was not located [The message can be deleted. Pg 9, Par 0064].

i. With regard to dependent claim 9, Bandini et al. teach the method of claim 6, further comprising the step of: determining whether the certificate for a recipient is locally available on the mobile device [Security manager queries trusted remote or local directories for digital certificate verification. Pg 6, 0047].

j. With regard to dependent claim 10, Bandini et al teach the method of claim 6, further comprising the step of: determining whether the certificate for a recipient is remotely available [Security manager queries trusted remote or local directories for digital certificate verification. Pg 6, 0047].

k. With regard to dependent claim 11, Bandini et al teach the method of claim 6, further comprising the step of collating certificates that correspond to the recipients before performing the validity check [Collating certificates are inherent when users are organized in a hierarchical directory type structure to facilitate grouping of users and/or domains. Pg 4, Par 0036].

l. With regard to dependent claim 12, Bandini et al teach the method of claim 6, wherein the message is to be encrypted using a Secure Multipurpose Internet Mail Extensions (S/MIME) scheme or a Pretty Good Privacy PGP scheme [Pg 4, Par 0037].

m. With regard to dependent claim 13, Bandini et al teach the method of claim 1, wherein the received data about a recipient's security key includes whether a recipient's certificate is permitted to be used; wherein the validity check issue indicates that the recipient's certificate is not permitted to be used [This is inherent in security protocols implementing digital certificates especially with a Certificate Revocation Lists (CRLs). Pg 8, Par 0058].

n. With regard to dependent claim 14, Bandini et al teach the method of claim 13, wherein the data about permission whether to use a recipient's

certification is based on a usage field contained in the certificate [Pg 8, Par 0058].

o. With regard to dependent claim 15, Bandini et al teach the method of claim 13, wherein the data about permission whether to use a recipient's certification is based on a control file installed on the mobile device that specifies which certifications are allowed to be used [There can be one or more CRLs which can be in trusted local or remote directories. Pg 8, Par 0058].

p. With regard to dependent claim 16, Bandini et al teach the method of claim 1, wherein the issue involves a validity check failure, said method further comprising the step of providing the reason of the validity check failure to the mobile device's user [A validation issues and failures are forms of triggering the security policy causing notification actions.].

q. With regard to dependent claim 17, Bandini et al teach the method of claim 1, wherein the received data about a recipient's security key includes strength of the recipient's certificate; wherein the validity check issue is directed to whether the recipient's certificate is permitted to be used based upon the strength of the recipient's certificate [Pg 8, Par 0058].

r. With regard to dependent claim 18, Bandini et al teach the method of claim 1, wherein the received data about a recipient's security key includes whether the recipient's certificate is trusted, wherein decision to include a recipient for a secure message is based upon whether the recipient's certificate is

trusted [This is inherent in certificate chain verification or root verification. Pg 8, Par 0058].

s. With regard to dependent claim 19, Bandini et al teach the method of claim 1, wherein the received data about a recipient's security key includes validity and revocation status of a recipient's certificate, wherein decision to include a recipient for a secure message is based upon the validity and revocation status of a recipient's certificate [Pg 8, Par 0058].

t. With regard to dependent claim 20, Bandini et al teach the method of claim 1, wherein the mobile device's user decides to send the message to a recipient despite being notified of the validity check issue [The messages can be sent to the specified destinations. Pg 9, Par 0064].

u. Claims 24 and 25 are rejected using the same reference of claim 1 because: With regard to dependent claim 24, it is inherent that computer readable media are implemented in the apparatus Bandini et al teach to perform the method of claim 1. Claim 25 is simply the apparatus performing the method of claim 1.

v. Based on independent claim 26, Bandini et al teach a communication device that handles a secure message to be sent to a recipient, comprising: a certificate store to store certificate data [The acceptable certificate list can be stored locally along with the CRL. Pg 8, Par 0058]; means for using the stored certificate data to perform a validity check with respect to using the message recipient's security key for sending a secure message to the recipient [Pg 8, Par

0058]; wherein an issue exists due to the validity check; means for determining a reason for the validity check issue; means for providing the reason of the validity check issue to the mobile device's user [Pg 5, Par 0044].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claim 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandini et al. [US Pub 2002/0169954 A1], and further in view of Baer et al. [US PN 6782266 B2].

a. With regard to dependent claim 21, Bandini et al teaches the method of claim 1, wherein means for providing a message server are used to transmit the

secure message from the mobile device. He does not teach the means for providing a wireless network. Baer et al. teaches the means for providing a wireless network [US PN 6782266 B2, Col 2, Ln 1-15]. Bandini et al. and Baer et al. are analogous art because they are both in the same inventive field of computer networking. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bandini et al. by coupling the wireless communication system with the server network using various communication links such as wireless gateways [US PN 6782266 B2, Col 2, Ln 57-66]. The suggestion/motivation for combining would have been to provide the need of allowing wireless communication devices to function in remote locations, over long-distance journeys, and in radio frequency sensitive locations [US PN 6782266 B2, Col 1, Ln 34-37]. Therefore, it would have been obvious to combine Bandine et al. and Baer et al.

b. Claim 22 is rejected using the same references and rationale as claim 21 since Baeir et al. teaches the mobile device as a handheld wireless mobile communications device or a personal digital assistant (PDA) [US PN 6782266 B2, Col 6, Ln 55].

c. Claim 23 is rejected using the same references and rationale as claim 21 since Baeir et al. teaches wireless communication having a data signal that is transmitted using a communication channel, wherein the data signal can include the secure message of claim 1; wherein the communication channel is a network,

wherein the data signal is packetized data that is transmitted through a carrier wave across the network [US PN 6782266 B2, Col 2, Ln 35-50].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Jeriko P. San Juan whose telephone number is 571-272-7875. The examiner can normally be reached on M-F 7:30a - 5:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph Del Sole

JOSEPH DEL SOLE
SUPERVISORY PATENT EXAMINER
5/29/07